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09/110, 145 07/02/98 EGGERT

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<input type="checkbox"/>	EXAMINER
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3723  
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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 11

Application Number: 09/110,145

Filing Date: July 2, 1998

Appellant(s): Daniel M. Eggert et al.

*8-2857m*  
**MAILED**

AUG 02 2000

**GROUP 37**  
*3200*

J. Terry Stratman  
For Appellant

**EXAMINER'S ANSWER**

This is in response to appellant's brief on appeal filed .

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

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**(3)     *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4)     *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5)     *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6)     *Issues***

The appellant's statement of the issues in the brief is correct.

**(7)     *Grouping of Claims***

The rejection of claims 15-21 stand or fall together since appellant's brief includes statements that this grouping of claims stand or fall together.

The rejection of claim 22 stands or falls by itself as indicated in appellant's brief.

**(8)     *ClaimsAppealed***

The copy of the appealed claims contained in Appendix "A" of the brief is correct.

**(9)     *Prior Art of Record***

No prior art is relied upon by the examiner in the rejection of the claims under appeal.

**(10)    *Grounds of Rejection***

Claims 15-22 are rejected under 35 U.S.C. 251. This rejection is set forth in prior Office action, Paper No. 4, paragraph 4.

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**(11) Response to Argument**

The examiner agrees with the discussion on pages 2-3 of the Brief as to the prosecution history and also agrees with the first paragraph of page 4 including the quote from the CAFC as follows:

“The recapture rule bars the patentee from acquiring, through reissue, claims that are of the *same* or of *broader scope* than those claims that were canceled from the original application.”

The examiner, however respectfully disagrees with the following statement which follows the CAFC quote since such statement does not apply to the CAFC quote that appellant relies upon:

“Thus, the recapture rule does not apply when the reissue claims are narrower in a material respect than the canceled claims, even though they may be broader in other respects.”

The recapture rule bars claims that are of broader scope than those claims that were canceled from the original application. Claims 15 and 22 are clearly of broader scope than those claims that were canceled from the original application since the recitation “retaining member being generally bowl-shaped and convex toward said magnet” was eliminated from these claims.

Appellant has admitted, in the first paragraph page 3, that “retaining member being generally bowl-shaped and convex toward said magnet” was added to claim 1 of the original patent to place the claim into condition for allowance. Consequently, the reissue claims are broader in a material respect than the canceled claims. Arguments directed to additional limitations that were added to the reissue claims or to limitations eliminated therefrom are not on point since such does not

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overcome the elimination of "retaining member being generally bowl-shaped and convex toward said magnet" which sets forth a reissue claim that is broader in a material respect.

Attention is additionally directed to arguments set forth by the examiner in the final office action, paper no. 4.

For the above reasons, it is believed that the rejections should be sustained.



Respectfully submitted,

dsm  
July 31, 2000

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